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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216429
Party	Plaintiff Proto Labs, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proto Labs, Inc. Opposer v. Nextline Manufacturing, Inc. Applicant	Opposition No. 91/216,429 Serial Nos.: 86/100,092, 86/100,112 86/100,123 and 86/100,133 Marks: NextLine, NextLine Manufacturing, NextQuote and Xpress Flow OG Publ. Dates: April 8 and March 18, 2014

PROTO LABS' BRIEF IN RESPONSE TO APPLICANT'S MOTION TO CONSENT/AMEND USE DATES

Opposer Proto Labs, Inc. ("Proto Labs") hereby files this brief in response to Applicant NextLine Manufacturing Corp.'s Consent To Judgment On Two Applications And Motion To Amend Remaining Applications ("Motion To Consent/Amend Use Dates"), served July 28, 2014.

In reply on its 12(b)(6) Motion and in its Motion To Consent/Amend Use Dates, Applicant has admitted that, at the time that it filed each of the four use-based applications at issue, Applicant had made **no** use of either any of the four marks in commerce nor of any of the four submitted specimens. Use of a mark in commerce prior to filing is a requirement for any application filed under 15 U.S.C. 1051(a). See 15 U.S.C. 1051(a)(1), 1051(a)(3)(C). Opposer Proto Labs believes that Applicant's admissions are sufficient in and of themselves for the Board to enter judgment in Opposer Proto Labs' favor against each of the four use-based applications being opposed. See *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917 (TTAB 2006).

Opposer Proto Labs does not contest entry of judgment against the NextQuote and Xpress Flow applications (Application Nos. 86/100,123 and 86/100,133), provided the entry of judgment in Proto Labs' favor pertains to all pleaded grounds of opposition. Opposer Proto Labs does contest entry of judgment against the NextQuote and Xpress Flow applications only to the extent that such an entry of judgment fails to specify the grounds for such judgment and as relevant to the entire course of fraudulent conduct/marketplace confusion of Applicant.

Opposer Proto Labs contests Applicant's motion to amend the first-use dates claimed in its four applications. A party is not entitled to registration of an innocently-filed use-based application for a mark which has not been used in commerce and based on a specimen which has not been used in commerce. A party is certainly not entitled to fraudulently file a use-based application, based upon a mark which has not been used in commerce and a specimen which has not been used in commerce, while swearing in the Application otherwise.

The "errors" which Applicant now claims were "innocently" made fully support a finding of fraud. The Board repeatedly has held that the fact that a party has set forth an erroneous date of first use does not constitute fraud **unless there was no valid use of the mark until after the filing of the application**. See, e.g. *Hiraga v. Arena*, 90 U.S.P.Q.2d 1102, 1107 (TTAB 2009); *Standard Knitting Ltd. V. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 1926 (TTAB 2006); *Western Worldwide Enterprises Group, Inc. v. Qinqdao Brewery*, 17 U.S.P.Q.2d 1137, 1141 (TTAB 1990); *Georgia Southern Oil Inc. v. Richardson*, 16 U.S.P.Q.2d 1723 (TTAB 1990); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 U.S.P.Q. 73 (TTAB 1983); *Girard Polly-Pig, Inc. v. Polly-Pig by Knapp, Inc.*, 217 U.S.P.Q. 1338, 1341 (TTAB 1983); *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 U.S.P.Q. 841, 841 (TTAB 1979); *Hecon Corp. v. Magnetic Video Corp.*, 199 USPQ 502 (TTAB 1978). The filing

date of each of the opposed applications was October 24, 2013. Applicant now admits that there was **no valid use in commerce of any of the four marks until more than three months after the filing** of each of the four use-based applications. When there was no valid use of the mark until after the filing of the use-based application, an erroneous date of first use does constitute fraud. See *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917 (TTAB 2006).

Even absent a finding of fraud, an application filed under 15 U.S.C. 1051(a) cannot have a first-use-in-commerce date after the filing of the application. 15 U.S.C. 1051(a)(1), 1051(a)(3)(C). Nor can the filing basis of a published, opposed application be voluntarily amended from 15 U.S.C. 1051(a) to 15 U.S.C. 1051(b). Nor can an amendment to assert use be considered after publication of an intent-to-use based application prior to allowance. See T.B.M.P. 219. Nor would an attorney's motion, without the necessary verification required under 15 U.S.C. 1051, satisfy the requirements of an amendment to allege use. Applicant's Motion To Consent/Amend Use Dates should be denied for all these reasons, with Judgment entered in Opposer Proto Labs' favor against each of the four applications.

Judgment in Opposer Proto Labs' favor should be entered against each of the four applications, rendering Applicant's motion to amend first-use dates moot. If judgment is not entered in Opposer Proto Labs' favor against each of the four applications, Applicant's motion to amend first-use dates should be denied.

Respectfully submitted,

SHEWCHUK IP SERVICES, LLC

By: /JDS/_____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PROTO LABS' BRIEF IN RESPONSE TO APPLICANT'S MOTION TO CONSENT/AMEND USE DATES has been served on Applicant Nextline Manufacturing Corp. by mailing said copy on August 8, 2014, via First Class Mail, postage prepaid to:

Bruce A. McDonald
BUCHANAN INGERSOLL & ROONEY PC
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By: /JDS/_____

Jeffrey D. Shewchuk